

REMARKS

The last Office Action of February 25, 2003 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1 and 3 are pending in the application. No claims have been amended or canceled

Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Theurer '499, of record in view of U.S. Pat. No. 5,301,548 (hereinafter "Theurer '548").

Applicants respectfully disagree with the Examiner's rejection of claim 1 and 3 under 35 U.S.C. 103(a) for the following reasons:

The present invention, as set forth in claim 1, is directed to a track surveying method which combines GPS measurement with a measurement using an optical beam, whereby the GPS measurement is provided to establish the position of the laser emitter **only once and only at the beginning** of each measurement cycle, while the subsequent surveying method is implemented through use of a laser reference line only, independent of additional GPS measurements. It is this novel and inventive combination of GPS measurement and optical measurement in this particular sequence that is relevant here and desirous to be protected.

Theurer '499 relates to a track surveying method using GPS measurement, whereby GPS measurement is repeated each time the

incrementally moving measuring vehicle is stopped during track survey. The thrust of Theurer '499 is the elimination of using a reference chord in the form of a laser beam (col. 2, lines 35-39) and the elimination of an optical visual communication between two measuring units (col. 2, lines 20 to 23). Please note in this context the passage in col. 6, lines 10 to 15, where it is stated that *"it is now unnecessary in the method according to the invention - as already described - to set up a laser reference chord for assistance purposes, since the position changes at the individual measuring points E may be determined by the satellite receivers."*

It is true that Theurer '499 refers to the use of a laser reference chord for assistance purposes because there may be situations when the GPS-system will not operate properly. The Examiner has interpreted this passage to include a constellation in which GPS measurement is used at the beginning surveying cycle and then as a consequence of, for example, bad weather, the use of the laser reference chord is applied to continue measurement. Applicants respectfully disagree with this line of reasoning and contend that the Examiner merely relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982. In the case at hand, Theurer '499 clearly teaches the desire to use a GPS system **repeatedly** to implement the **entire** track measurement, with the express intention to eliminate the need for a laser reference chord. There is no teaching or suggestion in Theurer '499 that

would lead an artisan to use a GPS system only **once**, namely at the start of the track surveying method, and then use only the optical measuring beam, **without the aid of the GPS receiver**, to survey the track.

It is well established that the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902. Clearly, Theurer '499 not only fails to teach or suggest the feature of combining a GPS measurement with an optical measurement for track surveying but also fails to teach or suggest the particular sequence in which the GPS measurement and the optical measurement are applied, i.e. GPS measurement at the beginning only, and then optical measurement only.

On page 3, last paragraph, the Examiner made a reference to the "stationary calibrated satellite receivers", as described in Theurer '499 in col. 8, first paragraph. These receivers are provided for **reception** of satellite signals and - as their position can be determined fairly accurately - can be used as reference points. These receivers do not emit any signals so that the Examiner's assessment that the mobile devices can be placed in the signal range of the stationary satellite receivers is inaccurate since there are no signals that emanate from these receivers.

Theurer '548 is directed to a track measuring car which includes a laser beam emitter and a laser beam receiver for monitoring the position of a track section. Again, applicants wish to emphasize that claim 1 does not claim per se the use of a laser beam for track surveying but a combination of optical

measurement and GPS measurement in a particular sequence, i.e. at the beginning the GPS system is applied while the remaining process is carried out using the optical reference line only.

It is also applicant's belief that a person skilled in the art would not combine the Theurer '499 reference with the Theurer '548 reference in a manner as suggested by the Examiner. As noted above, Theurer '499 describes a track surveying method that is intended to eliminate the need for laser beam measurement. Therefore, there is no motivation or incentive for an artisan to combine this reference with a reference that describes precisely the use of laser beam receivers to create the case of obviousness. It is well established that there must be some showing that a skilled artisan, confronted with the problems as the inventor, would select the elements from the cited prior art references.

It is applicant's contention, that the Examiner failed to make a prima facie case of obviousness and failed to explain the motivation one with no knowledge of applicant's invention would have to combine the references in a manner suggested.

For the reasons set forth above, it is applicant's contention that neither Theurer '499 nor Theurer '548, nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 1. None of the references discloses the combination of optical measurement and GPS measurement in a particular sequence, as set forth in claim 1.

As for the rejection of the retained dependent claim 3, this claim depends on claim 1, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

By: 

Henry M. Feiereisen
Agent For Applicant
Reg/No: 31,084

Date: May 23, 2003
350 Fifth Avenue
Suite 4714
New York, N.Y. 10118
(212)244-5500
HMF:af